REMARKS

This Response is submitted in reply to the Office Action dated April 1, 2005. Claim 24 has been canceled without prejudice or disclaimer. The specification has been amended. No new matter has been added by any of the amendments made herein. A Terminal Disclaimer and Supplemental Information Disclosure Statement are submitted herewith. A check in the amount of $310.00 is submitted herewith to cover the cost of the Terminal Disclaimer and the Supplemental Information Disclosure Statement. Please charge Deposit Account No. 02-1818 for any insufficiency or to credit any overpayment.

Applicant respectfully submits that the rejections in the Office Action have been overcome or are improper for at least the following reasons. Applicant therefore requests that the patentability of claims 1 to 23 and 25 to 32 be reconsidered.

In the Office Action, Claim 24 was rejected under 37 CFR §1.75 as being a substantial duplicate of Claim 23. Applicant has canceled Claim 24 without prejudice or disclaimer.

Claims 1 to 3, 5 to 11, 13 to 15, 18 to 20 and 22 to 25 were rejected under 35 U.S.C. §101 for statutory type double patenting. Applicant respectfully disagrees with and traverses this rejection and submits that the statutory double patenting rejection has been overcome or is improper for the following reasons.

Claim 1 was rejected under 35 U.S.C. §101 (statutory type double patenting) as claiming the same invention as that of Claims 1 and 7 to 11 of U.S. Patent No. 6,860,947 ("the '947 Patent"). Claim 1 of the above-identified patent application and Claims 1 and 7 to 11 of the '947 Patent are compared in Exhibit A attached hereto, where the compared term or terms in the claims are indicated in bold. Applicant respectfully submits that the statutory type double patenting rejection of Claim 1 should be withdrawn.

In determining whether a statutory basis for double patenting exists, the question is whether the same invention is being claimed twice. One test for double patenting under 35 U.S.C. §101 is to determine whether there is an embodiment of the invention that falls within the scope of one claim, but not the other claim. If there is such an

embodiment, the claims do not define identical subject matter and statutory double patenting does not exist. (See MPEP §804, p. 800-20).

Claim 1 of the '947 Patent includes "a coating means including a sprayer." In comparison, Claim 1 of the above-identified patent application includes "means positioned adjacent to the support means for applying an atomized coating to a section of the part." Under 35 U.S.C. § 112, a means plus function claim "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." The means for applying a coating defined by Claim 1 of the above-identified patent application therefore includes the structure described by the present specification and any equivalent structures. As a result in one embodiment, the coating means can by any equivalent structure and does not necessarily have to include a sprayer as defined by Claim 1 of the '947 Patent. Accordingly, there is an embodiment of the invention that falls within the scope of Claim 1 of the above-identified patent application which does not fall within the scope of Claim 1 of the '947 Patent.

Claim 1 of the above-identified patent application also defines the coating applied to the part as "an atomized coating." In comparison, Claim 1 of the '947 Patent includes coating means having a sprayer which applies "a coating" to the part. The coating defined by Claim 1 of the '947 Patent therefore does not have to be "an atomized coating." Thus, there is another embodiment of invention which falls within the scope of Claim 1 of the '947 Patent which does not fall within the scope of Claim 1 of the above-identified patent application.

Additionally, Claim 1 of the above-identified patent application includes coating the section of the part based on the dimension measurements taken during the application of the coating to the section of the part and a desired "final dimension." In comparison, Claim 1 of the '947 Patent applies the coating to the section of the part based on the dimension measurements and a "desired dimension." In an embodiment of the invention, the desired dimension may be a dimension which is not the final dimension such as applying the coating to the section of the part until a dimension which is 95% of the final dimension is achieved. Thus, there is an embodiment of the

invention that falls within the scope of Claim 1 of the '947 Patent which does not fall within the scope of Claim 1 of the above-identified patent application.

Claim 1 of the above-identified patent application also includes a laser generator and laser receiver which are each mounted in housing means. Each housing means includes a transparent member "connected" to the housing. In comparison, Claim 10 of the '947 Patent defines the transparent members as being "removably connected" to the housing. Thus in an embodiment of the invention, the transparent members could be connected to the housings without being removably connected to the housings. Accordingly, there is an embodiment of the invention that falls within the scope of Claim 1 of the above-identified patent application which does not fall within the scope of Claim 10 of the '947 Patent.

For at least these reasons, Applicant respectfully submits Claim 1 of the above-identified patent application and Claims 1 and 7 to 11 of the '947 Patent do not define identical subject matter and therefore statutory double patenting does not exist. Accordingly, Applicant respectfully requests that the rejection of Claim 1 under § 101 for statutory-type double patenting be withdrawn.

Claims 1 to 3 and 5 to 7 were rejected under 35 U.S.C. § 101 (statutory-type double patenting) as claiming the same invention as that of Claims 73 to 79 of the '947 Patent. Claims 1 to 3 and 5 to 7, and Claims 73 to 79 are compared in Exhibit B attached hereto, where the compared term or terms in the claims are indicated in bold. Applicant respectfully submits that the statutory type double patenting rejection of Claims 1 to 3 and 5 to 7 should be withdrawn.

As stated above, Claim 1 of the above-identified patent application defines the coating applied to the part as "an atomized coating." In comparison, Claim 73 of the '947 Patent includes means for applying "a coating" to a section of a part. The coating defined by Claim 73 of the '947 Patent therefore does not have to be "an atomized coating." Accordingly, there is an embodiment of invention which falls within the scope of Claim 73 of the '947 Patent which does not fall within the scope of Claim 1 of the above-identified patent application.

Furthermore, Claim 1 of the above-identified patent application includes coating the section of the part based on the dimension measurements taken during the application of the coating to the section of the part and a desired "final dimension." In comparison, Claim 73 of the '947 Patent applies the coating to the section of the part based on the dimension measurements and a "desired dimension" of the section of the part. As stated above, in an embodiment of the invention, the desired dimension may be a dimension which is not the final dimension such as applying the coating to the section of the part until a dimension such as an intermediate dimension of 95% of the final dimension is achieved. Accordingly, there is an embodiment of the invention therefore that falls within the scope of Claim 73 of the '947 Patent which does not fall within the scope of Claim 1 of the above-identified patent application.

Claim 76 of the '947 Patent further defines the coating means as including "a sprayer." In comparison, Claim 1 of the above-identified patent application includes "means positioned adjacent to the support means for applying an atomized coating to a section of the part." As stated above, the means for applying a coating defined by Claim 1 of the above-identified patent application can include equivalent structure to a sprayer but does not necessarily have to include a sprayer as defined by Claim 76 of the '947 Patent. Accordingly, there is an embodiment of the invention that falls within the scope of Claim 1 of the above-identified patent application which does not fall within the scope of Claim 76 of the '947 Patent.

Moreover, Claims 6 and 7 of the above-identified patent application include "means for displaying" the dimension measurements of the section of the part. In comparison, Claims 77 and 79 of the '947 Patent include a "display device." As stated above, the means for displaying the measurements covers the structure described in the specification and equivalents thereof. Thus, Claims 6 and 7 can be any equivalent structure and do not necessarily have to include a display device as defined by Claims 77 and 79 of the '947 Patent. Thus, there is an embodiment of the invention that falls within the scope of Claims 6 and 7 of the above-identified patent application which does not fall within the scope of Claims 77 and 79 of the '947 Patent.

For at least these reasons, Applicant respectfully submits that Claims 1 to 3 and 5 to 7 of the above-identified patent application and Claims 73 to 79 of the '947 Patent do not define identical subject matter and therefore, statutory double patenting does not exist. Accordingly, Applicant respectfully requests that the rejection of Claims 1 to 3 and 5 to 7 under § 101 for statutory-type double patenting be withdrawn.

Claims 9 to 11 were rejected under 35 U.S.C. § 101 (statutory-type double patenting) as claiming the same invention as that of Claims 80 to 81 of the '947 Patent. Claims 9 to 11 and Claims 80 to 81 are compared in Exhibit C attached hereto, where the compared term or terms in the claims are indicated in bold. Applicant respectfully submits that the statutory type double patenting rejection of Claims 9 to 11 should be withdrawn.

Claim 9 of the above-identified patent application includes "a part support adapted to support a part" wherein Claim 80 of the '947 Patent further defines the part support as including a conveyor. Applicant submits that the part support as defined by Claim 9 can by any suitable part support, and does not have to include a conveyor. Therefore, there is an embodiment of the invention that falls within the scope of Claim 9 of the above-identified patent application which does not fall within the scope of Claim 80 of the '947 Patent.

Additionally, Claim 80 includes a laser generator which projects a laser beam onto a section of the part. In comparison, Claim 9 includes a laser generator which projects a laser beam at "a level of a section of the part." Thus in an embodiment, the laser generator of Claim 80 can project a laser beam onto the whole part and not at a particular level of the part as defined by Claim 9. Accordingly, there is an embodiment of the invention which falls within the scope of Claim 80 and not within the scope of Claim 9.

Claim 80 also includes a "display device" in communication with the laser receiver and Claim 9 does not include such a display device. Thus, there is an embodiment of the invention which falls within the scope of Claim 9 and does not fall within the scope of Claim 80.

For at least these reasons, Applicant respectfully submits that Claims 9 to 11 of the above-identified patent application and Claims 80 to 81 of the '947 Patent do not define identical subject matter and therefore, statutory double patenting does not exist. Accordingly, Applicant respectfully requests that the rejection of Claims 9 to 11 under § 101 for statutory-type double patenting be withdrawn.

Claims 13 to 15 were rejected under 35 U.S.C. § 101 (statutory-type double patenting) as claiming the same invention as that of Claims 82 and 83 of the '947 Patent. Claims 13 to 15 and Claims 82 and 83 are compared in Exhibit D attached hereto, where the compared term or terms in the claims are indicated in bold. Applicant respectfully submits that the statutory type double patenting rejection of Claims 13 to 15 should be withdrawn.

Claim 82 is directed to a coating apparatus including a "display device positioned to face an operator." The claim further states that "the display device is operable to display the measurements of the dimension to the operator." Claim 13 does not include a display device or similar display. Therefore, there is an embodiment of the invention which falls within the scope of Claim 13 and does not fall within the scope of Claim 82.

For at least this reason, Applicant respectfully submits Claims 13 to 15 of the above-identified patent application and Claims 82 to 83 of the '947 Patent do not define identical subject matter and therefore statutory double patenting does not exist. Accordingly, Applicant respectfully requests that the rejection of Claims 13 to 15 under § 101 for statutory-type double patenting be withdrawn.

Claims 18 to 20 and 22 to 25 were rejected under 35 U.S.C. § 101 (statutory-type double patenting) as claiming the same invention as that of Claims 86 to 93 of the '947 Patent. Claims 18 to 20 and 22 to 25 and Claims 86 to 93 are compared in Exhibit E attached hereto, where the compared term or terms in the claims are indicated in bold. Applicant respectfully submits that the statutory type double patenting rejection of Claims 18 to 20 and 22 to 25 should be withdrawn.

Similar to above, Claim 18 of the above-identified patent application defines the coating applied to the part as "an atomized coating." In comparison, Claim 86 of the '947 Patent includes means for applying "a coating" to a section of a part. The coating

'947 Patent includes means for applying "a coating" to a section of a part. The coating defined by Claim 86 of the '947 Patent therefore does not have to be "an atomized coating." Accordingly, there is an embodiment of the invention which falls within the scope of Claim 86 of the '947 Patent which does not fall within the scope of Claim 18 of the above-identified patent application.

Furthermore, Claim 18 includes "measuring means" operable to measure a parameter of a section of the part. In comparison, Claim 86 is directed to a coating apparatus including measuring means having "a laser generator and a laser receiver." The "measuring means" of Claim 18 therefore can be any of the measuring means defined by the specification or equivalents thereof and does not have to include a laser generator and laser receiver as defined by Claim 86. For at least this reason, there is an embodiment of the invention that falls within the scope of Claim 18 and does not fall within the scope of Claim 86.

Claim 18 also includes an excess "coating reducer means" positioned adjacent to a transparent member. In comparison, Claim 86 defines an excess coating reducer "connected to a frame" and positioned adjacent to the transparent member. The excess coating reducer of Claim 18 therefore can be adjacent to the transparent member without having to be "connected" to the frame as in Claim 86. Accordingly, there is an embodiment of the invention that falls within the scope of Claim 18 which does not fall within the scope of Claim 86.

Additionally, dependent Claims 90 and 92 of the '947 Patent include a "display device" for displaying parameter measurements of the section of the part. In comparison, Claim 23 includes "means for displaying the parameter measurements" but does not specify that the means includes a display device. The display means of Claim 23 therefore can be any suitable display means and does not have to include a display device. For at least these reasons, there is an embodiment of the invention that falls within the scope of Claim 23 but does not fall within the scope of Claims 90 and 92.

Accordingly, Applicant respectfully submits Claims 18 to 20 and 22 to 25 of the above-identified patent application and Claims 86 to 93 of the '947 Patent do not define identical subject matter and therefore statutory double patenting does not exist. Thus,

Applicant respectfully requests that the rejection of Claims 18 to 20 and 22 to 25 under § 101 for statutory-type double patenting be withdrawn.

Claim 4 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 73 to 79 of the '947 Patent in view of U.S. Patent No. 6,376,013 to Rangarajan et al ("Rangarajan"). Similarly, Claim 21 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 86 to 93 of the '947 Patent in view of Rangarajan. Claims 27 to 30 were also rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 82 to 84 of the '947 Patent in view of Rangarajan. Applicant is hereby submitting a Terminal Disclaimer as indicated in the Office Action to overcome these rejections.

Claims 8, 12, 16 to 17, 26 and 31 to 32 were objected to as being dependent upon a rejected base claim. Claim 8 depends from Claim 1. Claim 12 depends from Claim 9. Claims 16 to 17 depend from Claim 13. Claim 26 depends from Claim 18 and Claims 31 to 32 depend from Claim 27.

As stated above, Applicant has submitted a terminal disclaimer to overcome the rejection of Claim 27. Therefore, Applicant respectfully submits that Claims 31 and 32 should be allowable for at least the reasons provided above with respect to Claim 27.

Additionally, Applicant respectfully submits that the objection of Claims 8, 12, 16 to 17 and 26 should be withdrawn because the rejection of Claims 1, 9, 13 and 18 has been overcome for the reasons provided above. Accordingly, Applicant respectfully submits that Claims 8, 12, 16 to 17 and 26 should be allowable for at least the reasons provided above with respect to Claims 1, 9, 13 and 18.

An earnest endeavor has been made to place this Application in condition for allowance, and such allowance is courteously solicited. If the Examiner has any questions related to this Response, Applicant respectfully requests that the Examiner contact the undersigned Attorney.

Respectfully submitted,

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